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EXAMINER	
BLAIR, DOUGLAS B	

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 10/06/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/595,501	WILLIAMS ET AL.	
	Examin r	Art Unit	
	Douglas B Blair	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2 and 3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 5-6, 9-11, 13, 15, 18, 20-28, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,381,634 to Tello et al..

3. As to claim 1, Tello teaches a method of communicating with an unknown mail server, comprising: determining whether a machine-selected one of a plurality of mail server names corresponds to a mail server associated with an on-line provider (col. 4, lines 57-67 and col. 5, lines 1-19); and communicating with the mail server associated with the on-line provider when the machine-selected one of plurality of mail server names corresponds to the mail server (col. 5, lines 15-42).

4. As to claim 2, Tello teaches the method of claim 1, wherein the determining includes: providing an e-mail address for the on-line provider (col. 3, lines 48-65); converting the e-mail address to a mail server name associated with on-line provider (col. 4, lines 57-67 and col. 5, lines 1-19); and linking to a mail port of a computer having the mail server name so as to verify whether the mail server name corresponds to the mail server associated with the on-line provider (col. 4, lines 57-67 and col. 5, lines 1-19).

5. As to claim 5, Tello teaches the method of claim 2, wherein the e-mail address includes a suffix portion; and wherein the converting includes obtaining the mail server name associated with the suffix portion from a database (col. 3, lines 48-65).

6. As to claim 6, Tello teaches the method of claim 5, further including: downloading the database from a remote computer (col. 3, lines 48-65).

7. As to claim 9, Tello teaches the method of claim 2, wherein the linking includes: communicating with a domain name server to determine a mail server IP address corresponding to the mail server name (col. 4, lines 57-67 and col. 5, lines 1-19); and connecting to the mail port of the mail server IP address (col. 4, lines 57-67 and col. 5, lines 1-19).

8. As to claim 10, Tello teaches the method of claim 1, wherein the on-line provider is a user-selected one of a plurality of on-line providers (col. 4, lines 12-33).

9. As to claim 11, Tello teaches the method of claim 1, wherein the communicating with the mail server includes: establishing at least one communication link from a group of communication links including an analog telephone line, a broadband link, a local are network, a radio frequency link, and an infrared link (col. 3, lines 7-25).

10. As to claim 13, Tello teaches a system for e-mailing information to a recipient over the Internet, comprising: an electronic device adapted for periodic connection to an Internet service provider and to a configuration computer (col. 4, lines 35-56), the electronic device having a parameter memory, a storage subsystem coupled to the parameter memory and responsive to a command from the configuration computer for storing configuration parameters in the parameter memory, and an e-mail subsystem coupled to the parameter memory and responsive to a user request to connect to an e-mail server of the Internet service provider using a server name and to

e-mail the information to the recipient (col. 5, lines 20-42); and a configuration program executable by the configuration computer to determine the server name from the user's e-mail address (col. 4, lines 57-67 and col. 5, lines 1-19).

11. As to claim 15, Tello teaches the system of claim 13, wherein the electronic device has an interface selected form the group consisting of a dialup modem, a digital subscriber line modem, a cable modem, a network interface, an infrared transceiver, and a radio frequency transceiver, the interface adapted to connect the device to the Internet service provider (col. 3, lines 7-25).

12. As to claim 18, Tello teaches a program storage medium readable by a computer apparatus, tangibly embodying a program of instructions executable by the computer apparatus for configuring an electronic device to send e-mail via a mail server of an Internet service provider, the program storage medium comprising: a first segment of the instructions configured to convert an e-mail address for a user of on-line access provider to a mail server name (col. 4, lines 57-67 and col. 5, lines 1-42); a second segment of the instructions configured to connect to the mail server using access information so as to verify validity of the mail server name (col. 4, lines 57-67 and col. 5, lines 1-42); and a third segment of the instructions configured to download the mail server name and a predetermined portion of the access information to the electronic device (col. 4, lines 57-67 and col. 5, lines 1-42).

13. As to claim 20, Tello teaches the program store of claim 18, further comprising: a fourth segment of the instructions configured to detect a change in the access information, and reconfigure the electronic device as required based on the change (col. 4, lines 57-67 and col. 5, lines 1-42).

14. As to claim 21, Tello teaches the program storage medium of claim 18, further comprising: a fifth segment of the instructions configured to receive data representing information to be sent to a specified recipient from the electronic device, connect to the mail server, and using the email server, transmit the information to the specified recipient as an e-mail message (col. 4, lines 57-67 and col. 5, lines 1-42).

15. As to claim 22, Tello teaches a method of configuring an Internet-enabled device to send e-mail, comprising: providing pre-configured access parameters for a user account of an Internet service provider (col. 4, lines 57-67 and col. 5, lines 1-42); determining a mail server name associated with the user account (col. 4, lines 57-67 and col. 5, lines 1-42); and storing the mail server name and a selected portion of the pre-configured access parameters to the Internet-enabled device (col. 4, lines 57-67 and col. 5, lines 1-42).

16. As to claim 23, Tello teaches the method of claim 22, wherein the determining includes: providing an e-mail address associated with the user account (col. 4, lines 57-67 and col. 5, lines 1-42); and converting the e-mail address to a mail server name (col. 4, lines 57-67 and col. 5, lines 1-42).

17. As to claim 24, Tello teaches the method of clam 23, wherein the determining includes: accessing a mail server of the Internet service provider corresponding to the mail server name so as to validate the mail server name (col. 4, lines 57-67 and col. 5, lines 1-42).

18. As to claim 25, Tello teaches the method of claim 22, further comprising: connecting a configuration computer to the user account using the pre-configured access parameters (col. 4, lines 57-67 and col. 5, lines 1-42); and connecting the configuration computer the Internet-enabled device (col. 4, lines 57-67 and col. 5, lines 1-42).

19. As to claim 26, Tello teaches the method of claim 25, wherein the determining includes: connecting the configuration computer to a mail server for the user account corresponding to the mail server name so as to validate the mail server name (col. 4, lines 57-67 and col. 5, lines 1-42).

20. As to claim 27, Tello teaches the method of claim 23, further comprising: connecting the Internet –enabled device to the user account; and sending an e-mail message to the mail address so as to verify successful configuration of the Internet-enabled device (col. 4, lines 57-67 and col. 5, lines 1-42).

21. As to claim 28, Tello teaches the method of claim 26, wherein the connecting to a mail server further comprises: querying a domain name server so as to determining an IP address of the mail server (col. 4, lines 57-67 and col. 5, lines 1-42); and connecting to mail port of the IP address (col. 4, lines 57-67 and col. 5, lines 1-42).

22. As to claim 31, Tello teaches the method of claim 22, wherein the Internet-enabled device is a multifunction peripheral (col. 3, lines 48-65).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

24. Claims 3-4, 7-8, 12, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,381,634 to Tello et al. in view of U.S. Patent Number 5,987,508 to Agraharam et al..

25. As to claim 3, Tello teaches the method of claim 2, wherein the e-mail address includes a suffix portion; however Tello does not teach pre-pending a mail server prefix to an address suffix.

Agraharam teaches a method wherein an e-mail address includes a suffix portion; and wherein the converting includes pre-pending a selected one of a predetermined set of mail server prefixes to the suffix portion to form the mail server name associated with the on-line provider (col. 3, lines 24-50).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Tello regarding a method for delivering e-mail with the teachings of Agraharam regarding pre-pending a mail server prefix to an address suffix because a prefix allows for easier routing of e-mails (Agraharam, col. 3, lines 24-50).

26. As to claim 4, Agraharam teaches a method wherein an e-mail address includes a first prefix portion and a first separator portion, and wherein the converting includes stripping the first prefix portion and the first separator portion from the e-mail address (col. 3, lines 24-50), and appending a second separator to the selected one of a predetermined set of mail server prefixes so as to form the mail server name associated with the on-line provider (col. 3, lines 24-50).

27. As to claim 7, Agraharam teaches a method including if validity of the mail server name is not verified, repeating the pre-pending and linking using a different one of the predetermined set of mail server prefixes (col. 3, lines 24-50).

28. As to claim 8, Agraharam teaches a method wherein the suffix is a domain identifier, the first prefix is a mailbox identifier, the first separator is an "@" symbol, the second prefix is a mail server prefix, and the second separator is a "." symbol (col. 3, lines 24-50).

29. As to claim 12, Agraharam teaches a method wherein the suffix portion includes at least two domain levels and a separator between each of the at least two domain levels, and wherein the converting further includes stripping a left-most domain level and a left-most separator from the suffix portion prior to the pre-pending if the suffix portion includes more than two domain levels (col. 3, lines 24-50).

30. As to claim 14, it features the same limitations as claim 4 and is rejected for the same reasons as claim 4.

31. As to claim 19, it features the same limitations as claim 12 and is rejected for the same reasons as claim 12.

32. Claims 16-17, 29, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,381,634 to Tello et al. in view of U.S. Patent Number 6,525,768 to Obradovich.

33. As to claim 16, Tello teaches the system of claim 13; however Tello does not explicitly teach determining a maximum size supported by the e-mail server.

Obradovich teaches determining a maximum size supported by the e-mail server (col. 29, lines 26-40).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Tello regarding delivering e-mail with the

teachings of Obradovich regarding determining a maximum e-mail size because oversized emails could exceed a device's memory space (Obradovich, col. 29, lines 26-40).

34. As to claim 17, Obradovich teaches a system wherein the e-mail subsystem splits the information into one or more e-mail messages, each e-mail message having a size of not more than the maximum e-mail message size (col. 29, lines 26-40).

35. As to claim 29, it features the same limitations as claims 16 and 17 and is rejected for the same reasons as claims 16 and 17.

36. As to claim 32, Tello teaches the method of claim 22; however Tello does not teach the device being a camera.

Obradovich teaches a device configured to send e-mail being a camera (col. 23, lines 5-35).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Tello regarding delivering e-mail with the teachings of Obradovich regarding sending email with a camera because pictures are commonly transmitted by e-mail.

37. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,381,634 to Tello et al. in view of U.S. Patent Number 6,574,670 to Eguchi.

38. As to claim 30, Tello teaches the method of claim 22; however Tello does not teach the device being a scanner.

Eguchi teaches a device configured to send e-mail being a scanner (col. 10, lines 25-44).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Tello regarding delivering e-mail with the

teachings of Eguchi regarding sending email with a scanner because pictures are commonly transmitted by e-mail.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair
September 30, 2003
DBB

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER